

**REMARKS**

Claims 1-24, 26 and 27 are pending in the application.

Claims 1-5, 8-17 and 20-24 have been rejected.

Claims 7, 19 and 27 have been amended. These amendments have been made to correct dependency relationships between these claims and claims from which they depend. Applicants respectfully submit that these amendments do not affect the rationale expressed in the Office Action related to the indicated allowability of these claims nor do these amendments narrow the scope of these claims.

Claims 6, 7, 18, 19, 26 and 27 have been objected to as being dependent upon a rejected based claim, but are indicated to be allowable if rewritten in independent form. Appreciation is expressed for the indicated allowability of these claims, but Applicants decline to do so at this time in lieu of the discussion presented below. Applicants, however, reserve the right to present the requested amendments at a later time.

**Rejection of Claims Under 35 U.S.C. § 103**

Claims 1, 2, 5, 8-14, 17 and 20-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2005/0063647 issued to Thornton *et al.* ("Thornton"). Applicants respectfully traverse this rejection.

In order for a claim to be rendered invalid under 35 U.S.C. §103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. §103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation

of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

**Independent Claims 1, 13 and 24:** Applicants respectfully submit that independent Claims 1, 13 and 24 contain limitations that are not disclosed by Thornton, either alone or, as suggested by the Office Action, in combination with the knowledge of one of ordinary skill in the art. All of these independent claims contain limitations of the following form:

- An optical connector interface coupled to said third I/O port and configured to...coupled said optical network connector to said first I/O port; and
- An electrical connector interface coupled to said third I/O port and configured to...couple the electrical network connector to said second I/O port.

*See* Claim 1. Applicants respectfully submit that Thornton fails to disclose these claim limitations.

The Office Action refers to ¶53 of Thornton as providing much of the disclosure of the independent claims.

Turning now to Figs. 10A and 10B, in a configuration similar to that of Fig. 4, proximal end 130'' of light pipe 120 may be coupled (as shown in fanthom) to a sidewall 180 of an upper receptacle 212. Lower receptacle 312 may be supplied with optical signals via a channel, whole or similar recess 90 extending from a light source 22 to the receptacle, thus obviating the need for a light pipe.

Thornton, ¶53. The Office Action relates element 212 of Fig. 10B to the claimed optical connector interface and element 312 to the claimed optical network connector. As an initial matter, Applicants note that Thornton refers to element 212 as an upper receptacle and element 312 as a lower receptacle. Applicants further note that neither Fig. 10B, illustrating elements 212 and 312, nor ¶53 disclose element 212 as coupling element 312

to a first I/O port, as claimed. The Office Action merely provides a blanket citation to ¶53 of Thornton, but, as shown above, there is no disclosure within that paragraph of such a coupling. In fact, Figures 10A, 10B and 4 illustrate that elements 212 and 312 are merely vertically stacked receptacles with no other operative coupling disclosed between them.

In addition, the claims call for an optical connector interface and an electrical connector interface. Thornton makes no disclosure of both an optical connector interface and an electrical connector interface being coupled in the manner claimed. The only reference to optical signals made at all in the cited section of Thornton refers to a light pipe carrying light from a light source to the receptacles to indicate activity. The cited section appears to disclose the receptacles 212 and 312 as adapted to receive electrical network connectors, and not optical network connectors. There is no disclosure in Thornton that indicates that receptacles 212 and 312 can be non-homogeneous; that is, not both being of one type, either electrical or optical. Finally, should the Examiner consider the light pipes of Thornton to be an optical connector interface (a proposition with which Applicants do not agree), Applicants submit that the claimed optical interface is an input and output (I/O) port, whereas Thornton's disclosed light pipe is merely an outbound signal carrier.

The independent claims also provide for the optical connector interface and electrical connector interface to both be coupled to the same "third I/O port." Thornton provides no disclosure of the disclosed receptacles being coupled to the same I/O port. The Office Action acknowledges this lack of disclosure by indicating that Thornton does not disclose a first, second, or third I/O port, as claimed. *See* Office Action, p. 3. To compensate for this lack of disclosure, the Office Action asks that one

[c]ompare Figure 3 of Thornton et al. with Figure 1 of the Application, they are identical, therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention for Thornton et al. to have a first input/output (I/O) port, a second input/output (I/O) port and a third input/output (I/O) port in view of Figure 1 of Thornton et al. so that to have the interface connections as claimed.

Office Action, pp. 3-4. Thus, the Office Action suggests that the missing disclosure in Thornton can be provided by comparing Thornton to the present application as a suggestion for such a combination. Applicants respectfully submit that such an argument fails to establish a *prima facie* case of obviousness and is a hindsight analysis of the reference in light of the application. The Office Action makes no showing of a motivation to combine Thornton with the first, second, and third I/O ports from within Thornton itself; therefore, it must be presumed that there is no such motivation to combine. It is well-established that the best defense to hindsight is a “rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” *See Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000); *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000). A showing of combinability must be “clear and particular” and “broad conclusive statements about the teaching of multiple references, standing alone, are not ‘evidence.’” *See Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666 (Fed. Cir. 2000); *Brown & Williamson*, 229 F.3d at 1125.

The reason, suggestion, or motivation to combine may be found explicitly or implicitly: (1) in the prior art references themselves; (2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or (3) from the nature of the problem to be solved, “leading inventors to look to references relating to possible solutions to that problem.”

*Ruiz*, 234 F.3d at 665.

The Office Action presents nothing more than broad, generalized statements relating to the motivation of a person of ordinary skill, which applicants respectfully submit is insufficient to support a finding of obviousness. The Office Action does not establish that Thornton is of special interest or importance in the field. Nor does the Office Action present any evidence of a problem to be solved from within Thornton itself.

In fact, Thornton relates to a completely different problem and does not purport to solve the problem suggested by the present application (e.g. “to present a single network element port to a user which includes both an optical connector interface and an electrical connector interface” (Application, ¶5)). Thornton purports to provide “an improved status indication system for stacked and other configurations of multi-receptacle receptacle assemblies,” using a light pipe to transfer light from a source to the inside of Thornton’s disclosed receptacles. *See* Thornton, ¶11. Further, Thornton provides no disclosure of the disclosed receptacles being anything but homogeneous in type. That is, both the upper and lower receptacles (212 and 312) are of the same type. As clearly claimed in the present invention, and as presented in the problem statement of the present application, a problem solved by the present application relates to having both an optical and electrical connector interface being coupled to the same I/O port.

Without having disclosure of the problem solved by the present application within Thornton, the Office Action fabricates such a problem to be solved, not from the teachings of Thornton, but from the teaching of Applicants’ own disclosure (e.g., “[c]ompare Figure 3 of Thornton et al. with Figure 1 of the Application”).

Using Applicants’ own disclosure as a blueprint from providing the motivation to combine a prior art references in an obviousness determination with another reference or

the knowledge of one of ordinary skill in the art in impermissible. *See W. L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552-53 (Fed. Cir. 1983) (“to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious affect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”). Applicants respectfully submit that from the discussion presented in the Office Action that the Office Action is presenting such an impermissible analysis.

For at least these reasons, Applicants respectfully submit that the Office Action fails to present a *prima facie* case of obviousness of Claims 1, 13 and 24, and all claims dependent upon them, and that they are therefore in condition for allowance. Applicants therefore respectfully request the Examiner’s reconsideration and withdrawal of the rejections to those claims and an indication of allowability of same.

**Dependent Claims 3, 4, 15 and 16:** Dependent Claims 3, 4, 15 and 16 are rejected over the combination of Thornton with U. S. Patent No. 6,692,159, issued to Chiu *et al.* (“Chiu”). The Office Action cites Chiu as disclosing an optical connector interface comprising either a small form factor pluggable (SFP) optical module or a gigabit interface converter (GBIC) optical module. But Applicants respectfully submit that the Examiner has not satisfied the burden of supporting the alleged motivation to combine the two references. The Office Action presents nothing more than broad, generalized statements relating to the motivation of a person of ordinary skill, which Applicants respectfully submit is insufficient to support a finding of obviousness. Indeed, it appears that the Office Action takes the Thornton reference and then seeks to add parts to it by using the Application itself as a blueprint for that process.

The Office Action further does not establish that one would have a reasonable expectation of success in the combination of Thornton with Chiu. It is not clear from the references whether the size of the Thornton apparatus is compatible with the size of SFP or GBIC optical modules as disclosed in Chiu. Further, it is not clear from the references whether SFP or GBIC optical modules would provide the advantages sought in providing light sources to the interior of receptacles as disclosed by Thornton (e.g., there is no disclosure that an SFP or GBIC connector provides the necessary translucency to transmit the light being transmitted into a receptacle by a Thornton device).


Additionally, even should the combination result in incorporation of an SFP or GBIC optical module in the receptor disclosed in Thornton, it still would not anticipate the claims for the reasons discussed both in this section and in the previous section. For example, Thornton does not provide disclosure of the claimed optical and electrical connectors in the claimed configuration, nor does Thornton provide disclosure of a non-homogeneous collection of interfaces, and Thornton does not provide for both an optical and electrical connector interface to be coupled to the same “third I/O port,” and Chiu is not argued to provide such missing disclosure. Further, there is no motivation to combine Thornton with Chiu.

For these reasons and those previously expressed, Applicants respectfully submit that the Office Action fails to present a *prima facie* case of obviousness of Claims 3, 4, 15, and 16, and all claims dependent upon them, and that they are therefore in condition for allowance. Applicants respect the Examiner’s reconsideration and withdrawal of the rejection as to those claims and an indication of the allowability of same.

CONCLUSION

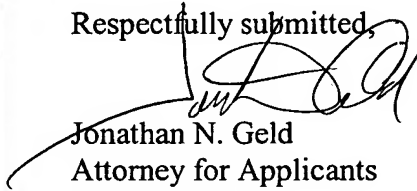
In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, COMMISSIONER FOR PATENTS, P. O. Box 1450, Alexandria, VA 22313-1450, on May 16, 2006.

  
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5/16/2006  
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